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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,071	01/20/2004	Robert H. Cichewicz	MSU 4.1-691	3185
21036	7590	07/23/2004	EXAMINER	
MCLEOD & MOYNE, P.C. 2190 COMMONS PARKWAY OKEMOS, MI 48864			PESELEV, ELLI	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/761,071	Applicant(s) CICHEWICZ ET AL.	
	Examiner Elli Peselev	Art Unit 1623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-33 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                                    |

The disclosure is objected to because of the following informalities: page 1 of the specification fails to set forth priority to the parent application S.N. 10/317,906.

Appropriate correction is required.

Claims 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "alkyl", "substituted alkyl", "alkene", "substituted alkene", "aryl", "substituted aryl", "cyclic", "substituted cyclic", "acid group", "carbohydrate" and "aldehyde" encompass such a large number of diverse structural formulas that it would take an undue amount of experimentation to determine how to make the various compounds encompassed by the instant claims and to determine whether said compounds have any biological activity. For example, the term "alkyl" is not limited to any number of carbon atoms and encompasses an alkyl having 200 carbon atoms, the term "aryl" encompasses benzene, naphthalene, anthracene, and phenanthrene, the term "aldehyde" encompasses formaldehyde, acetaldehyde, propionaldehyde, butyraldehyde, benzaldehyde and salicylaldehyde, and the term "carbohydrate" encompasses monosaccharides, disaccharides and polysaccharides. The specification fails to set forth any guidance of how to choose any specific substituents, fails to describe what is encompassed by various substituents and what is encompassed by the term "substituted".

Claims 22-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terminology "combinations thereof" renders claims 22-23 indefinite because it reads on one variable representing more than one moiety at the same time.

The markush terminology "R is ... methyl, alkyl" (claims 22-23) is improper because the term "alkyl" encompasses the term "methyl".

The compound numbers in claim 24 are superfluous.

A period is missing at the end of claims 25-33.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midiwo et al (Int. J. BioChemiPhysics 2: 115-116 (1993), Li et al (J. Nat. Prod. 52:660-662 (1989), Danielson et al (Magn. Reson. Chem. 30 : 359-360 (1992) or Schripsema et al (Phytochem. 51 :55-60 (1999).

Midiwo et al disclose the claimed compounds wherein R is methyl, R1 is hydroxy, R2 is H, OH or COCH3, R3 is OH and R4 is H, OH or OCH3.

Li et al disclose the claimed compounds wherein R is CH3, R1 is OH, R2 is OH, R3 is OH and R4 is H.

Danielson et al disclose the claimed compounds wherein R is CH3, CH2OH, CO2H or OH, R1 is OH, R2 is H, R3 is OH and R4 is H or CH3.

Scripsema et al disclose the claimed compounds wherein R is H, R1 is OH, R2 is H or CH3, R3 is OH or OCH3 and R4 is OH or OCH3.

A claim to a composition containing old chemical compound and a carrier for compound is not patentable. Recital of carrier is unpatentable limitation. The effective ingredient, chemical compound, is still old and that it is carried by a solvent, such as water, does not change the effective character of the compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (571) 272-0659. The examiner can normally be reached on 9.00-5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elli Peselev

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